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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of:)
John Eric Arnold)
For: PART NUMBER)
IDENTIFICATION TAG)
Serial No.: 10/069,301)
Filed: February 18, 2002)

Confirmation No. 2013
Docket No. DN1999215USA
Art Unit: 3683
Examiner: Melanie Torres

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Aug 16, 2004
(Date of Deposit)
Nancy T. Krawczyk, Reg. No. 38,744
(Name of Applicant, Assignee or Registered Representative)
[Signature] 8-16-04
(Signature) (Date of Signature)

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

AMENDMENT UNDER 37 C.F.R. § 1.111

Dear Sir:

In response to the Office Action mailed on July 8, 2004, please consider the following arguments.

35 U.S.C. § 103(a)

Claims 1-9 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Geno et al in view of Robinson. This rejection is respectfully traversed for the reasons set forth below.

Geno is cited as disclosing an airspring comprising a flexible cylindrical sleeve having a first and second end, a retainer secured to one of the ends of the sleeve. It is recognized that Geno fails to teach a tag made from a sheet material wherein a portion of the tag is non-removably secured between the sleeve and retainer.

To make up for the deficiency of Geno, the teachings of Robinson are applied. Robinson is cited for disclosing a tag made from a sheet material wherein a portion of the tag is non-removably secured between a sleeve (1) and a retainer (5). It is held that it would have been obvious to one of skill in the art to have "had the tag of Hofe" [this presumable should have read 'had the tag of Robinson'] on the air spring of Geno to provide identification for the

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Date: August 16, 2004

To: Melanie Torres, Examiner
U.S. Patent & Trademark Office

Fax #: 703-872-9306

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Number of pages transmitted: 4
INCLUDING this cover sheet

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Re: U.S. Patent Application 10/069,301
Filed February 18, 2002
Confirmation No. 2013
Docket No. DN1999227USA

Transmitted herewith with an amendment in the above identified patent application.

**Nancy T. Krawczyk
Patent Attorney**

manufactured part.

Applicants respectfully disagree with this rejection and the holding of obviousness as set forth in the Office Action for the following reasons.

As appreciated in the Office Action, Geno fails to disclose a tag of sheet material. In fact, Geno provides no form of identification tagging for the air spring.

Robinson discloses a method of providing tags for can-like containers; Robinson being specifically concerned about paint cans with the tag providing information regarding the contents of the can (pg 1, lines 3-5). The tag is provided with a tongue or projection that is passed through a hole formed in the lid of the can-like container (pg 1, lines 13-18).

To establish *prima facie* obviousness, there 1) must be some suggestion or motivation in the art to modify or combine the references; 2) must be a reasonable expectation of success and 3) the combined references must teach or suggest all the claim limitations.

First, there is no motivation in the art to modify Geno or combine the teachings of Robinson with Geno. Geno is silent about any need to provide an external identification tag. Robinson teaches that the tag is to provide information about the contents of the can; for an air spring there is no such need – those skilled in the art know what is inside an air spring – air.

Second, to modify the air spring of Geno in the manner as taught by Robinson, the retainer of Geno must be provided with a hole through which the tag must pass through. Because the goal of an air spring is to have control over the airflow into and out of the air spring, to simply punch a hole into the retainer would potentially destroy the operability of the air spring. One skilled in the art would not seek to place additional holes in the retainer. Additionally, Robinson teaches the use of an additional lip over the can-like container that cooperates with the lid and the tag. The addition of a similar lip is not practical for the sleeve of an airspring, as the lip of Robinson requires the material of both the lip and the container to be a non-flexible material, which an air spring sleeve is not.

The Examiner has failed to establish *prima facie* obviousness as the rejection fails to meet all three of the requirements established by Graham v. Deere.

Additionally, it is stated in the Office Action that the reason to provide a tag would be to provide identification for the manufactured part. However, that reasoning is not taught by either Geno or Robinson; the argued motivation is not present in either reference. The only motivation to provide Geno with a part identification tag is provided within the content of Applicant's specification. To combine these references in the manner set forth in the Office Action is solely based upon hindsight provided by Applicant's own teachings. There is no motivation to combine these references other than to make the present rejection.

It is requested that the Examiner please reconsider the rejection of Geno in view of Robinson, and the rejection be withdrawn.

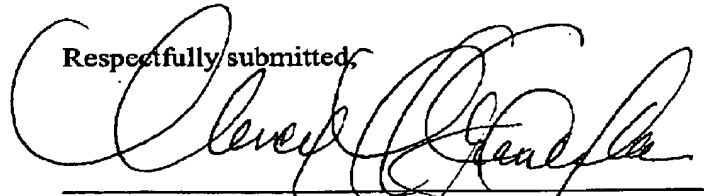
Claim 8 has been rejected under U.S.C. 103(a) as being unpatentable over Geno et al. in view of Robinson and further in view of Brewster. This rejection is respectfully traversed for the reasons set forth below.

This rejection is based on the above rejection of Geno in view of Robinson; however, as argued above, *prima facie* obviousness has not been established for the rejection of claim 1. It is respectfully requested that this rejection also be reconsidered and withdrawn.

Claim 10

It is noted that there is no rejection set forth for claim 10; however, the cover sheet of the Office Action states that claim 10 stands rejection. Clarification would be appreciated.

Respectfully submitted,



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